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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,459	07/16/2003	Wataru Ishimaru	088473-0136	7706

22428 7590 08/11/2004

FOLEY AND LARDNER  
SUITE 500  
3000 K STREET NW  
WASHINGTON, DC 20007

EXAMINER

LEWIS, TISHA D

ART UNIT PAPER NUMBER

3681

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/619,459

Applicant(s)

ISHIMARU, WATARU

Examiner

TISHA D. LEWIS

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### **DETAILED ACTION**

The following is a first action on the merits of application serial no. 10/619,459 filed on July 16, 2003.

#### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Information Disclosure Statement***

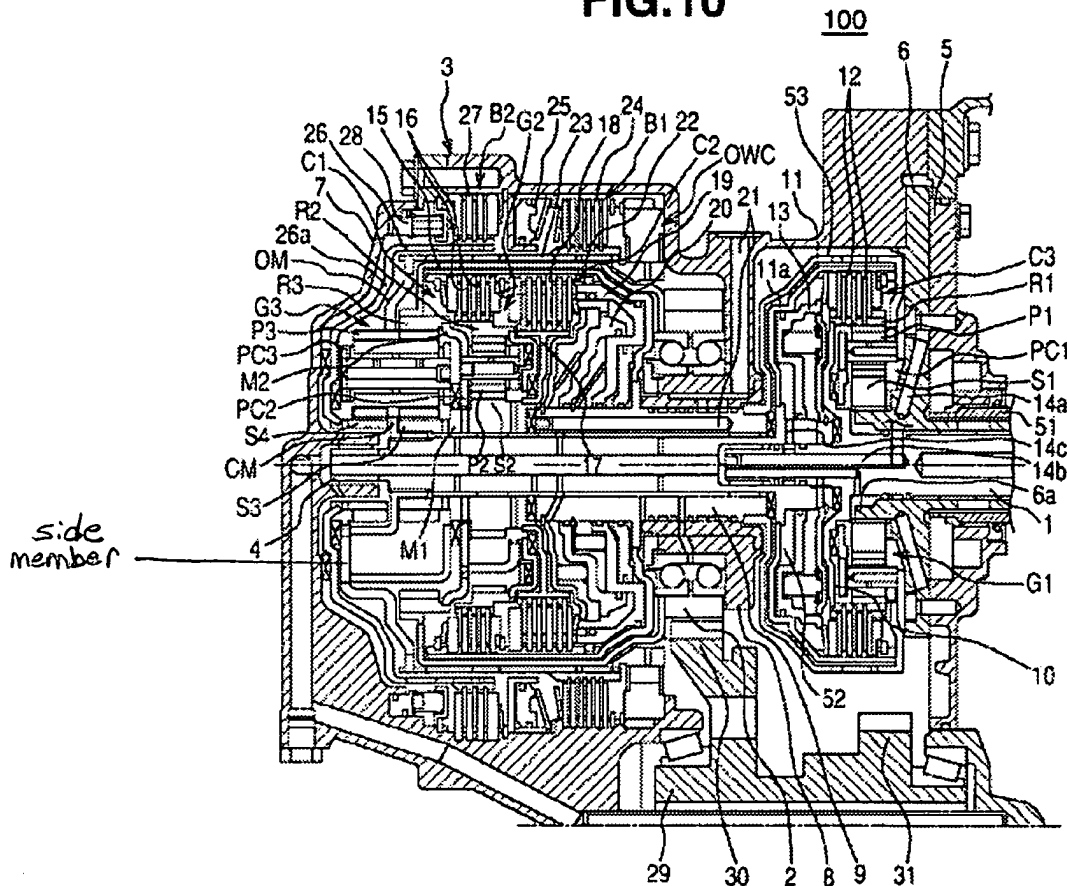
The information disclosure statement filed on July 16, 2003 has been acknowledged.

#### ***Claim Rejections - 35 USC § 102***

Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Tsuga ('551). As to claims 1 and 18, Tsuga discloses a gear change speed unit for an automatic transmission having, an input part (1), an output part (2), three planetary gear sets (G1, G2, G3), clutches (C1-C3) and brakes (B1, B2) providing at least six forward speed and one reverse speed (Figure 2), the first gear set reducing input rotation at all times and having a first sun gear (S1), a first pinion (P1), a first ring gear (R1) and a first carrier (PC1), the second gear set having a second sun gear (S2), a second pinion (P2), a second ring gear (R2), the third gear set having a third and fourth sun gear (S3, S4), a third pinion (P3) meshed with both sun gears, a third ring gear (R3), a third carrier (PC3), a center member (CM) coupled to a side member (Figure 10) supporting the third pinion with the third sun gear being close to the input part and the fourth sun gear being distant from the input part, the second and third gear sets constituting a change

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speed planetary and the first, second and third gear sets are parallel in this order from the input part.

**FIG.10**

As to claim 2, Tsuga discloses the first and second clutches (C1, C2) providing output from the first gear set arranged closer to the second gear set than the third gear set.

As to claim 3, Tsuga discloses the first and second clutches having pistons (Figure 10) arranged on the side of the second gear set distant from the third gear set.

As to claim 4, Tsuga discloses the third clutch (C3) providing rotation of the input part arranged at an outer periphery of the first gear set.

As to claim 5, Tsuga discloses the third clutch having a piston (Figure 10) arranged on a side of the first gear set closer to the second gear set.

As to claim 6, Tsuga discloses the output part (2) is disclosed between the first and second gear sets.

As to claim 7, Tsuga discloses a transmission casing provided with a wall (8) for supporting the output part to the casing.

As to claim 8, Tsuga discloses hydraulic passages (21) formed through the wall communicating with the first and second clutches.

As to claim 9, Tsuga discloses the first and second brakes (Figure 10) arranged closer to the second gear set than the third gear set.

As to claim 10, Tsuga discloses both brakes arranged at an outer periphery of the first and second clutches (Figure 10).

As to claim 11, Tsuga discloses the first brake (B1) fixing the third carrier (PC3), the second brake (B2) fixing the fourth sun gear (S4) and the first brake being disposed closer to the first gear set than the second brake.

As to claim 12, Tsuga discloses the input part coupled to the first ring gear (R1) and the output part coupled to an integrated unit of the second carrier and third ring gear (Figure 1), wherein the first clutch engages the first carrier from the second ring gear, the second clutch engages the first carrier with the integrated unit, the third clutch engages the third carrier from the input part, the first brake fixes the third carrier, the second brake fixes the fourth sun gear, and wherein the first speed is obtained by engaging the first clutch and brake, second speed is obtained by engaging the first

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clutch and second brake, third speed is obtained by engaging the first and second clutches, fourth speed is obtained by engaging the first and third clutches, fifth speed is obtained by engaging the second and third clutches, sixth speed is obtained by engaging the third clutch and second brake and reverse speed is obtained by engaging the second clutch and first brake (Figures 2-9).

As to claim 13, Tsuga discloses the same arrangement as claimed in Figures 12-19.

As to claims 14 and 15, Tsuga discloses a coupling member (M2) which couples the output part to an integrated unit of the second carrier and third ring gear, wherein the output part is disposed between the first and second gear sets, the first and second clutches are arranged at the inner periphery of the coupling member, the first and second brakes are arranged at the outer periphery of the coupling member, an outer member (OM) coupled to the first brake and extending radially outward from the third carrier in a middle position of the third pinion, a radial member (26a) coupling the second brake to the fourth sun gear and extending radially outward from the fourth sun gear, an intermediate shaft (4) arranged through the second and third gear sets, and wherein the third clutch is disposed at an outer periphery of the first gear set, the third clutch having a drum coupled to the third carrier through the intermediate shaft and center member (Figure 20).

As to claim 16, the first gear set is a single pinion gear set (Figure 1).

As to claim 17, the first gear set is a double pinion gear set (Figure 12).

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Claims 1-12, 16 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Tsuga ('550). This reference has same reference characters/limitations as rejection above for Tsuga ('551).

Claims 1-12, 16 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Choi ('549). This reference has same reference characters/limitations as rejection above for Tsuga ('551).

The applied references have a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the references, each constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the references was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 16-18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No. 10/343,924. Although the conflicting claims are not identical, they are not patentably distinct from each other because both disclose an input, an output, three sets of planetary gear sets, clutches and brakes for obtaining at least six forward speeds and one reverse speed, one of the gear sets (first gear set) reducing speed of input at all times (always) and the other remaining gear sets (second and third gear sets) is a double sun gear (third and fourth sun gears) meshing with a pinion which meshes with a ring gear and a carrier having a center member positioned between the sun gears.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### **FACSIMILE TRANSMISSION**

Submission of your response by facsimile transmission is encouraged. Group 3600's facsimile number is **(703) 872-9326 before final and 703-872-9327 after final**. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence not permitted by facsimile transmission, see MPEP 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check should not be submitting by facsimile transmission separately from the check.



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Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP 512). The following is an example of the format the certification might take:

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Typed or printed name of person signing this certificate:

\_\_\_\_\_

\_\_\_\_\_

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-Ishimaru et al ('737), Lane ('535) and Japanese patent 2004052808A are cited as having automatic transmissions using double sun gears. The Ishimaru et al patent is also a 102(e) reference as well as the WIPO publication ('314), but were not applied to reduce redundancy in the same type of rejection as applied above using Tsuga and since these two can also be overcome by filing of 1.131 or 1.132 as stated above.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to TISHA D. LEWIS whose telephone number is 703-305-0921. The examiner can normally be reached on M-Thur 8 AM TO 3 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CHARLES A. MARMOR can be reached on 703-308-0830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tdl  
August 9, 2004

  
TISHA LEWIS  
PRIMARY EXAMINER  
Au 3681 8/9/04